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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,954	08/16/2000	Cathy C. Northington	16762.093A	3314

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COVINGTON & BURLING
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EXAMINER


SNAPP, SANDRA S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/638,954	Applicant(s) NORTHINGTON ET AL.	
	Examiner Sandra Snapp	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-39 is/are pending in the application.
4a) Of the above claim(s) 30-39 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 11-29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 16 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the election made by Applicant on 4-22-04. Currently claims 11-29 are pending in the application, and claims 30-39 have been canceled in view of the Amendment.

Priority

The Examiner acknowledges the Applicant claims priority to provisional application, serial no. 60, 063,633, filed 10-27-1997.

Specification

The abstract of the disclosure is objected to because it is too long, it exceeds the 150 word limit. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 22, 24 and 29 are objected to because of the following informalities:

Claim 22 is objected to because the phrase “for the date that are” is grammatically incorrect. The Examiner suggest the phrase “for the *dates* that are.”

Claim 24 is objected to because the term “transaction” should be plural “transactions” in order to be grammatically correct.

Claim 29 is objected to because the phrase “corresponding to transaction performed” is grammatically incorrect. The Examiner suggests “corresponding to *a* transaction performed”.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

Claims 11-22 and 24-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 11-22 and 24-29 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-22 and 24-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is indefinite because it claims a “system” however it is unclear to the Examiner what the Applicant means by a system, for example, is it referring to a computer system, an

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accounting system or some other type of system. If it is a computer system, amending the claim to read as such may also overcome the rejection based on 35 U.S.C. 101.

Claims 12-22 and 24-29 are indefinite because they depend from rejection base claim 11.

Claims 13 and 14 are indefinite because the phrase “the total” lacks proper antecedent basis. Since this is the first occurrence of this element, in both claims, the element should be preceded by “a”. Also, with claim 14, it is unclear to the Examiner what is “external” the ledger or the entity?

Claim 22 is indefinite because it is unclear which “date” the Applicant is referring to. Is the date from claim 22 the same date as the stored date referred to earlier in the claim, or is it the date from claim 11? Clarification is required.

Claim 29 is indefinite because it depends from rejected base claim 22.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 11-29 are rejected under 35 U.S.C. 102(e) as being anticipated by the Watson patent (US 5,991,750).

The Watson reference discloses a method for reconciling transaction data of an entity comprising:

Receiving by a system of an intent data element that represents a transaction to take place on a date (col. 5, lines 1-11),

Storing the intent data element with a date code corresponding to the date in a database of the system (col. 5, lines 25-27),

Receiving by the system of a transaction data element that represents a transaction that occurred on the date (col. 5, lines 28-39),

Responsive to a match between the transaction data element and the intent data element for the date, assigning a reconciled code to the matching transaction data element to form a

reconciled transaction data element and to the intent data element to form a reconciled intent data element and storing the reconciled transaction data element and the reconciled intent data element in the database (col. 5, lines 28-39),

Responsive to no match between the transaction data element and any intent data element stored in the database for the date, assigning an unreconciled code to the transaction data element to form an unreconciled transaction data element and storing the unreconciled transaction data element in the database (col. 11, line 58 through col. 12, line 5), and

Preparing a total of all transaction performed on the date (Fig. 5) (claim 11);

Preparing a total debit amount (Fig. 5), and preparing a total credit amount (Fig. 5) (claim 12);

Storing the total in the database (col. 5, lines 25-27) (claim 13);

Transmitting the total to a general ledger system of the entity that is external to the system (col. 4, lines 18-34, inherent in “reconciled system”) (claim 14);

Repeating the step of preparing a total responsive to receipt by the system of another transaction data element (Fig. 5) (claim 15);

Transmitting the reconciled transaction data element and the reconciled intent data element to a financial system external to the system (col. 4, lines 18-34) (claim 16);

Transmitting the reconciled transaction data element and the reconciled intent data element to a division system of the entity that is external to the system (col. 4, lines 18-34) (claim 17);

Transmitting the unreconciled transaction data element to a financial system external to the system (col. 11, line 58 through col. 12, line 5) (claim 18);

Transmitting the unreconciled transaction data element to a division system of the entity that is external to the system (col. 11, line 58 through col. 12, line 5) (claim 19);

The intent data element is received from a financial system external to the system (col. 5, lines 1-27) (claim 20);

The intent data element is received from a division system of the entity that is external to the system (col. 5, lines 1-27) (claim 21);

Comparing the transaction data element with intent data elements for the dates that are stored in the database to determine the match between the transaction data element and the intent data element for the date (col. 11, line 58 through col. 12, line 5) (claim 22).

The Watson patent also discloses a system that comprises:

A network and gateway services element for accessing a plurality of financial systems (col. 4, lines 61-67, inherent in Internet),

A navigator for identifying one or more sources of information required by the system to reconcile transactions of the entity in response to control commands received from a remote access terminal or from one or more of the plurality of financial systems, and for generating corresponding source access command signals (col. 4, lines 61-67, inherent in Internet), and

A session manager coupled to the navigator for generating session commands in response to the source access command signals generated by the navigator, wherein the network and gateway services element access the financial systems in response to session commands received from the session manager (col. 4, lines 61-67, inherent in Internet) (claim 23);

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Receiving by the system of audit data that comprises audit data elements corresponding to transaction performed by a financial system external to the system (Fig. 5) (claim 24);

Responsive to the receipt of audit data, comparing the audit data elements with the reconciled transaction data elements and the unreconciled transaction data elements (col. 11, line 58 through col. 12, line 5) (claim 25);

Identifying discrepant audit data elements that do not have corresponding reconciled transaction data elements or unreconciled transaction data elements (col. 11, line 58 through col. 12, line 5) (claim 26);

Identifying discrepant reconciled transaction data elements that do not have corresponding audit data elements (col. 11, line 58 through col. 12, line 5) claim 27);

Identifying discrepant unreconciled transaction data elements that do not have corresponding audit data elements (col. 11, line 58 through col. 12, line 5) (claim 28); and

Receiving by the system of audit data that comprises audit data elements corresponding to transaction performed by a financial system external to the system (col. 11, line 58 through col. 12, line 5) (claim 29).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Chancey, Haluska, Armetta, Langhans, Lyons, Atkins, Cameron, Gallery, Uchiyama, Riboud, Shirasaki, Bissonett, Nair, Nolan, Golson and Northington patents are all directed to various types of electronic financial systems.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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